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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,048	03/02/2000	Robert Barritz	P/1318-73	5346

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OSTROLENK FABER GERB & SOFFEN
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NEW YORK, NY 100368403

EXAMINER

HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
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2134

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/518,048

Applicant(s)

BARRITZ ET AL.

Examiner

Matthew Heneghan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-43 and 46-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-43 and 46-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 34-43 and 46-51 have been examined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 34, 35, 47-41, and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,105,069 to Franklin et al.

As per claim 34, and the Licensing Controller disclosed by Franklin, which constitutes a knowledge base facility, organizes databases into objects, such as for users, resources (such as computers or software application objects), and software licenses (see column 4, line 17 to column 5, line 50). The resources are organized into a database (see column 2, lines 29-33) that constitutes an inventory list. A linking between resource and license objects is also described (see column 10, lines 50-60). Franklin also includes a query tool (see column 4, line 66 to column 5, line 21) for using the various databases that outputs query results.

Franklin further discloses that licensing objects may be implemented as API's (see column 2, lines 62-67; column 7, line 40 to column 8, line 8; and column 9, lines 4-20) and discloses a procedure that retrieves licensing information from the respective resources and a process by which necessary additional functionalities may be spawned by the applications (see figure 12 and column 14, line 12 to column 15, line 64).

Franklin does disclose embodiments wherein the product is used for database maintenance by an administrator rather than for the direct execution of a software product, including the display of linked data (see column 16, lines 12-23 and figures 11 and 12). Since the operation of the licensed software is not essential for this functionality, the negative limitations of Applicant's claims are anticipated.

Regarding claim 35, it is disclosed that the system may be run on a single system (see column 4, line 6) or a network of computers. Any package that can be run on a single system inherently can be used on a mainframe.

As per claims 37-39, a "numbers" attribute tracks installations, while the "metering" attribute may track actual usage (see column 11, lines 33-57).

As per claims 40 and 41, licensing attributes may include multiple contract terms, such as the charges (see column 6, lines 28-40).

Regarding claim 48, a properly keyed database is inherently capable of correlating 100% of related data.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al.

Franklin discloses that the invention may be used on a single computer such as a server, but does not specifically state that the computer be a mainframe.

Official notice is given that the use of mainframes as servers is well-known in the art, as mainframes are designed for serving large-scale environments.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of Franklin on a mainframe computer, as mainframes are designed for serving large-scale environments.

4. Claims 46, 47, 50, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. as applied to claim 34 above, and further in view of U.S. Patent No. 6,049,799 to Mangat et al.

Regarding claims 50 and 51, the "backlink" attribute disclosed by Franklin provides the means for the immediate updating of linking information when information in the corresponding tables are changed (see column 12, lines 13-27); however, no disclosure is given as to when the updating should actually take place.

Mangat discloses the updating of linking information upon the updating of the corresponding application (see column 11, lines 3-10), and suggests that this is to establish and re-make links (see column 2, lines 9-13).

Regarding claims 46 and 47, though Franklin discloses the use of different distinguished names to identify objects (see column 5, lines 22-30), a method for correlating objects based upon their distinguished names is not disclosed.

Mangat discloses the use of fuzzy logic to associate different documents with similar distinguished names (see abstract).

Mangat further suggests that this all is to establish and re-make links (see column 2, lines 9-13).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by updating of linking information upon the updating of the corresponding applications, and by using fuzzy logic to associate databases by their distinguished names, as disclosed by Mangat, in order to establish and re-make links.

5. Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. as applied to claim 34 above, and further in view of U.S. Patent No. 5,867,714 to Todd et al.

Though Franklin discloses a means for incorporating new software product data into the database, the way in which software products are acquired is not disclosed (see column 15, lines 3-17).

The software distribution system disclosed by Todd distributes software from a remote server to computers (see abstract), and suggests that this allows for the remedying of faults before they actually become faults (see column 3, lines 1-8).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by distributing software from a remote server to computers on a periodic basis, as disclosed by Todd, in order to remedy problems before they actually become faults.

6. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. as applied to claim 34 above, and further in view of Elmasri et al., "Fundamentals of Database Design," 1989, pp. 544-545.

Franklin does not disclose the updating of databases on a periodic basis.

Elmasri discloses the updating (committing) of databases periodically at checkpoints, and suggests that this aids recovery in the event of a system crash.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by updating the databases using checkpoints, in order to aid recovery in the event of a system crash.

Response to Arguments

7. Applicant's arguments filed 17 January 2007 have been fully considered but they are not persuasive.

Regarding Applicant's argument that that an executable that is not the API as disclosed by Franklin interfaces with the software facilities, Franklin includes an embodiment in which an API "performs all ... (use) of the licensing attributes." See column 15, lines 11-14. Therefore, the API is the executable that is disclosed by Franklin in that embodiment, and the corresponding limitations are anticipated as described above.

Regarding Applicant's argument that Franklin does not teach to a system that "is not operable to affect operation of any software product," in the examination of a patent application, the meanings of claim terms are given their broadest reasonable interpretation in light of Applicant's specification. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000), *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-17 (Fed. Cir. 2005) (en banc).

Given that the claimed invention requires the use of an API in the software products (as per the first two limitations and Specification, p. 12, lines 23-26), which is executable code, one would not reasonably ascertain that the claimed invention does not allow for the software products to be devoid of any execution, since the invention would not be able to function; rather, a reasonable interpretation of the claim would be that in being "not operable to affect operation," the software product is executed at least to the extent that the API is effected, without interfering with the software product's other functionality. There is no reason to believe that Franklin does not do this; claim 34 is therefore anticipated and all of the remaining claims are further unpatentable for the reasons stated above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand, can be reached at (571) 272-3811.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Art Unit: 2134

Or faxed to:

(571) 273-3800

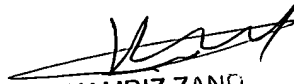
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH



February 28, 2007



KAMBIZ ZAND
PRIMARY EXAMINER

Matthew Heneghan, USPTO Art Unit 2134